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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/914,033

08/22/2001

Ieyasu Kobayashi

8235

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EXAMINER

RIVERA, WILLIAM ARAUZ

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAR - 5 2010

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Washington DC 20036

In re Application of	:	
Ieyasu KOBAYASHI et al.	:	DECISION ON PETITION
Application No. 09/914,033	:	UNDER 37 CFR §1.181
Filed: August 22, 2001	:	
For: Polyester Film Roll	:	

This is a decision on Applicant's Petition under 37 CFR 1.181 filed on November 18, 2009 to withdraw the rejection of claims 6, 9, 13-15, and 23 in the non-final Office action of September 2, 2009 (9/2/09) because the rejection used the same reference as the rejection that has already been reversed by the Board of Patent Appeals and Interferences (the Board).

The Petition is **GRANTED IN PART**.

Applicant alleges that the rejection of claims 6, 9, 13-15, and 23 in the Office action mailed 9/2/09 used the same reference that has previously been applied in a rejection and subsequently reversed by the Board.

A review of the file history reveals that a final Office action was mailed on August 10, 2004 in which claims 1-3, 16-18 were rejected under 102(b) by Sasaki et al. (U.S. patent 4,576,344), claims 4-15 and 19-24 were rejected under 103(a) by Sasaki et al. Applicant filed an appeal brief on September 5, 2006. The examiner issued an examiner's answer on October 2, 2007. The Board rendered a decision on April 30, 2009. Specifically, the Board reversed the final rejections of claims 1-24 over Sasaki (claims 1-3 and 16-18 under 35 USC 102(b) and claims 4-15 and 19-24 under 35 USC 103(a)) and entered new grounds of rejection for claims 1-5, 12, 16-22, and 24 under 102(b)/103(a) over Sasaki but with a different interpretation of the reference. Further, the Board stated that "...we emphasize that our decision does not mean the remaining claims are patentable. Rather, we merely leave the patentability determination of these claims to the Examiner." See the last paragraph on page 13 of the Board's decision.


On June 23, 2009, applicant submitted an amendment in response to the Decision on appeal by canceling claims 1-5, 7-8, 10-12, 16-22, and 24 and amending the remaining claims 6, 9, 13-15, and 23 into independent form. It is noted that claims 6, 9, 13-15 and 23 were not rejected by the Board.

In view of the Board's decision, it was deemed proper to reopen prosecution of the application. Therefore, the non-final Office action was issued on September 2, 2009 was appropriate. The non-final Office action included a rejection of claims 6 and 9 under 35 USC 103(a) over Sasaki which included appropriate portions of the Board's new grounds of rejection. The non-final Office action also included a rejection of claims 13-15 and 23 under 35 USC 103(a) over Sasaki in view of Ogawa (U.S. Patent 4,911,951); Ogawa being a new reference not previously relied upon in the final rejection. The new rejections of claims 6, and 13-15 are proper because the examiner relies on the rationales provided by the Board, and a new combination of references, respectively. For claims 6, and 13-15 the examiner acted in a manner consistent with the Board's Decision and did not reinstate a previously reviewed rejection.

However, the new rejections of claims 9 and 23 were similar to the rejections of the same claims in the final rejection which the Board has already reversed. Therefore, the rejections of claims 9, and 23 in the non-final Office action of September 2, 2009 are withdrawn. This application will be forwarded to the examiner for a new Office action.

SUMMARY: The Petition is **GRANTED IN PART**.

Any questions regarding this decision should be directed to Supervisory Patent Examiner John Q. Nguyen at 571-272-6952.


David L. Talbott, Director
Patent Technology Center 3600
571-272-5150

LM/JQN: 2/25/10

LM